

REMARKS

Applicant is in receipt of the Office Action mailed November 12, 2003. New claims 44-50 were added. Thus, claims 1-10, 13-29, and 31-50 remain pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

Section 103 Rejections

Claims 1, 2, 4, 5-7, 11, 13-15, 18-20, 24-28, 35, 336, 42, and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Marrion et al. (U.S. Pat. No. 6408429, "Marrion"), in view of Perez et al. (U.S. Pub. No. 2002/0116666 A1, "Perez"), Yusuf et al. (U.S. Pat. No. 6256199, "Yusuf"), Shaffer et al. (U.S. Pat. No. 5966427, "Shaffer"), Mori et al. (U.S. Pat. No. 5821627, "Mori"), and Stumme (U.S. Pat. No. 5273428, "Stumme").

Claims 3, 8-10, 21-23, and 37-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Marrion, in view of Perez, Yusuf, Shaffer, Mori, and Stumme, and further in view of Masuda et al. (U.S. Pub. No. 2002/0122582 A1, "Masuda").

Applicant respectfully disagrees.

As the Examiner is certainly aware, to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). As held by the U.S. Court of Appeals for the Federal Circuit in Ecolochem Inc. v. Southern California Edison Co., an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." In re Dembiczak,

175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

As noted in the prior Response, Marrion discloses “a set of step tools from which a set of step objects is instantiated, said set of step objects comprising machine vision step objects that comprise routines for processing an image of an article to provide article feature information” (claim 1). As also disclosed in the Abstract of Marrion, the machine vision step objects “comprise routines for processing an image of the article to provide article feature information.”

The Office Action admits that Marrion does not teach the one or more non-machine vision tests in addition to the plurality of machine-vision tests, but asserts that Perez teaches a system that, combined with Marrion, teaches this feature. Applicant respectfully disagrees.

Perez discloses a system and method for testing a group of related products or devices (Abstract). More specifically, Perez discloses creation of a base test sequence, then creating a plurality of child test sequences based on the base test sequence, where each child test sequence is initially a copy of the base test sequence. Each child test sequence is then manually edited to customize the sequence for a particular product. As stated in the Summary of Perez (paragraph [0030]), the primary benefit of Perez’s system is that by basing child test sequences on a base test sequence, the user doesn’t have to recreate each sequence from scratch, but rather, only has to make “minor alterations” to each instance of the base test sequence.

While Perez indicates that the disclosed system and method is applicable for testing any type of related products, suggesting a group of data acquisition (DAQ) boards for performing signal input/output as an example, nowhere does Perez teach or suggest creating a test sequence that combines a plurality of machine-vision tests with one or more non-machine vision tests.

Applicant submits that the field of computer based automated testing is an active, well developed field with crowded art, and that those skilled in the art have diligently pursued improvements in the systems and methods used, as evidenced by numerous patents, publications, and products related to this domain, including the various patents cited in the Office Action. In other words, there are many people skilled in the art of automated testing who are actively pursuing improvements in automated testing tools and processes. However, the prior art systems are each directed to a different fundamental type or class of testing, such as, for example, machine vision testing, where an image of an article is analyzed to determine features of the article (e.g., Marrion, Masuda), or physical testing, where a physical, e.g., electrical or mechanical, property is tested (e.g., Yusuf, Shaffer, Mori, Strumme). These two fundamentally different types of testing require correspondingly different testing infrastructures, and so prior art testing systems and methods have each focused on specific testing types or classes. Thus, Applicant submits that this feature of claim 1, i.e., the novel combination of fundamentally different test types (machine-vision and non-machine vision tests) created in a single test sequence, is neither taught or suggested in the cited art.

Regarding the Yusuf, Shaffer, Mori, Stumme, and Masuda references, Applicant submits that the Examiner has simply combined test types and procedures from a variety of different applications in an attempt to re-construct Applicant's invention. Applicant submits that while one skilled in the art may realize that the different references may be combined, this does not in itself constitute a motivation to combine.

As stated in *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 488 (Fed. Cir. 1984), "The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Applicant respectfully submits that nothing in the cited prior art suggests the desirability of making the combination as presented in claim 1. More specifically, as stated in *Uniroyal, Inc. v. Rudkin Wiley Corp.*, 837 F.2d 1044, 1051 52, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988) "it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so." Finally, as stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227

USPQ 543, 551 (Fed. Cir. 1985) “it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor”.

Applicant notes that there is nothing in any of the cited references that indicates that a combination of two fundamentally different testing types or classes would improve the automated testing processes taught by the references. Applicant thus submits that the Examiner has relied on hindsight analysis *only*, based upon Applicant's invention as represented by claim 1.

Thus, Applicant submits that neither Marrion, Perez, Yusuf, Shaffer, Mori, Stummern nor Masuda, either singly or in combination, teaches or suggests all of the features of claim 1, and that none of the cited references provides a motivation to combine. Thus, Applicant respectfully submits that claim 1, and claims dependent thereon, are unobvious, and patentably distinct over the cited art, and are thus allowable for at least the reasons presented above.

Applicant further notes that independent claims 19, 21, 23, 24, 39, 42, and 43, and new claim 44, each contains the feature of creating a test sequence that includes a plurality of machine-vision tests and one or more non-machine-vision tests, and so for at least the reasons provided above, Applicant submits that these claims, and claims respectively dependent thereon, are patentably distinct over the cited art, and are thus allowable.

Removal of the 103 rejection of claims 1, 2, 4, 5-7, 11, 13-15, 18-20, 24-28, 35, 336, 42, and 43 is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recited further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

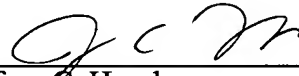
Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-61801/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Change of Address

Respectfully submitted,



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